

inconsistency. Accordingly, Applicant respectfully suggests that the § 112 rejection be withdrawn.

B. REJECTION OF CLAIMS 1-3 AND 12 UNDER § 102

The Examiner rejects 1-3 and 12 § 102(b) as being anticipated by *Mayfield*. Applicant has amended claim 1 and deleted claim 12. Accordingly, Applicant respectfully suggests that the § 102 rejection be withdrawn.

C. REJECTION OF CLAIMS 4-11 UNDER § 103(A)

Examiner rejects claims 4-11 under § 103(a) as being unpatentable over *Mayfield*. Regarding claims 7-10, the Examiner argues that *Mayfield* discloses the method of applying the label to the exterior of the receptacle. Regarding claim 11, the Examiner argues that the label has first and second sides, the first side having an adhering surface and the second side having an external printable media. The Examiner acknowledges that *Mayfield* does not disclose the specific arrangement and/or content of indicia set forth in claims 4-9 and 10. However, the Examiner argues that it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide any type of graphic representation of a cover because it would only depend on the intended use of the assembly and the desire information to be displayed. Finally, the Examiner cites *In Re Gulack*, 217 U.S.P.Q. 401 (Fed. Cir. 1983) in support of the rejection. As explained below, Applicant respectfully suggests that the Examiner withdraw the § 103 rejection.

1. Claims 4-11 Are Not Obvious In View of MAYFIELD

The claims of the invention recite descriptive icons or labels comprising pictures that can be universally understood by either the patient or their caregiver. Specifically, the claims recite: (1) a label or graphic depicting why the medicine is being used; (2) a label or graphic depicting

the results of the consumption of the medicine; and/or (3) a label or graphic depicting the symptoms for which the medicine is designed. In fact, the Examiner recognizes that *Mayfield* does not disclose such labels or graphics. Office Action, p. 4. However, the Examiner argues that such labels are obvious in view of *Mayfield*. Applicant respectfully disagrees.

Applicant respectfully suggests that the Examiner's reliance on *Mayfield* is misplaced. *Mayfield* discloses tabs comprising generic, non-descriptive geometric shapes that perform a different function than Applicant's label. Specifically, *Mayfield* discloses various generic geometric shapes that correspond to geometric shapes on a chart. It is only through use of the chart coupled with geometric shape on the label that one knows what prescription is contained in the bottle. Perhaps over time, one might associate a shape with a particular medicine. However, Applicant's invention performs a new function by having a descriptive graphic or pictorial representation that itself depicts the medicine. Thus, in Applicant's invention there is no need to refer to or read an external chart or to memorize the association between a particular geometric shape and a medicine. Rather, the descriptive graphic representation itself, *i.e.*, a heart or showing a person sleeping (see Figure 3), immediately conveys to the user what type of medicine is in the container. Accordingly, Applicant's invention does provide a new functional relationship and thus is patentable over *Mayfield*. Therefore, Applicant respectfully suggests that the claims are not obvious in view of *Mayfield*.

Applicant's descriptive labels will permit easy recognition of the medicine. Examples would be an eye for eye medications, an ear for ear medications, or a knee for knee medications, a hammer hitting a thumb to depict pain medicine, etc. The invention would be beneficial to patients with diminished eyesight, because these descriptive labels are larger and easier to see than the drug's name on the chart in *Mayfield*. Additionally, an advantage of Applicant's

invention is its simplicity. The simple, universally understandable, descriptive pictures on the labels would not be limited by language barriers and would not require additional items such as the chart of *Mayfield*. Therefore, Applicant respectfully suggests that the § 103 rejection be withdrawn.

2. *In Re Gulack*

In support the § 103(a) rejection, the Examiner cites *In Re Gulack*, 217 U.S.P.Q. 401 (Fed. Cir. 1983), for the proposition that mere support by the substrate for the printed matter is not the kind of functional relationship necessary for patentability. Applicant respectfully suggests that *Gulack* does not require rejection of Applicant's claims. *Gulack* establishes that "[d]ifferences between an invention and the prior art cited against it cannot be ignored merely because those differences reside in the content of the printed matter." *Id.* at 403. *Gulack* further establishes that all of the limitations of the claims, including the printed matter limitations, should be considered in determining whether the invention would have been obvious. *Id.* at n.8. As the *Gulack* court noted, the "CCPA, notably leery of reiterating this point, clearly stated that printed matter may well constitute structural limitations upon which patentability can be predicated." *Id.* Based on these principles, the Federal Circuit set forth the following test:

What is required is the existence of *differences* between the appealed claims and the prior art sufficient to establish patentability. The bare presence or absence of a specific functional relationship, without further analysis, is not dispositive of obviousness. Rather, the critical question is whether there exists any new and unobvious functional relationship between the printed matter and the substrate.

Id. at 404.

As explained above, a new and unobvious functional relationship exists in Applicant's claims. Applicant's invention performs a new function by having a descriptive graphic representation that itself depicts the medicine. There is no need to refer to or read an external

chart, or to memorize the association between a particular geometric shape and a medicine. Rather, the descriptive graphic representation itself immediately conveys to the user what type of medicine is in the container. Accordingly, *Gulack* supports a finding that Applicant's invention is patentable over *Mayfield*. Therefore, Applicant respectfully suggests that the § 103(a) rejection be withdrawn.

D. DRAWING AMENDMENT

In a drawing amendment filed herewith, Applicant amends Figure 1 as suggested by the Examiner.

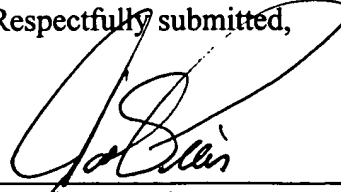
Conclusion

During the course of these remarks, Applicant has at times referred to particular limitations of the claims that are not shown in the applied prior art. This short-hand approach to discussing the claims should not be construed to mean that the other claimed limitations are not part of the claimed invention. They are as required by law. Consequently, when interpreting the claims, each of the claims should be construed as a whole, and patentability determined in light of this required claim construction. Unless Applicant has specifically stated that an amendment was made to distinguish the prior art, it was the intent of the amendment to further clarify and better define the claimed invention and the amendment was not for the purpose of patentability. Further, although Applicant has amended certain claims, Applicant has not abandoned its pursuit of obtaining the allowance of these claims as originally filed and reserves, without prejudice, the right to pursue these claims in a continuing application.

If the Examiner has any questions or comments regarding this communication, she is invited to contact the undersigned to expedite the resolution of this application. For all of the

foregoing reasons, Applicant submits that all claims are in condition for allowance, which action is respectfully suggested.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Jonathan M. Pierce', is written over a horizontal line.

Jonathan M. Pierce

Reg. No. 42,073

Conley, Rose & Tayon, P.C.

P. O. Box 3267

Houston, Texas 77253-3267

(713) 238-8000

ATTORNEY FOR APPLICANT

APPENDIX A

MARKED-UP VERSION OF AMENDED CLAIMS

CLAIMS

WHAT IS CLAIMED:

1. (Once Amended) [An apparatus for marking a medicine] A receptacle for medicine, comprising:

a housing having an open end and an external surface, said housing configured to retain dosages of the medicine;

a cover to be removably secured to said open end, said cover separating the medicine held within from an outside environment; and

[an] a descriptive iconic label capable of identifying the medicine without reference to another source.[, said label being disposed on said cover to graphically describe the medicine held therein.]

[3. The apparatus of claim 1 wherein said iconic label further comprises a representation that communicates to a patient application for which the medicine is to be used by the patient.]

4. (Once Amended) The apparatus of claim 1 wherein said iconic label depicts the reason [further comprises a representation that communicates] why the medicine is being used [prescribed].

5. (Once Amended) The apparatus of claim 1 wherein said iconic label [further comprises at least one drawing to] depicts the results of the consumption of the medicine by a patient.

6. (Once Amended) The apparatus of claim 1 wherein said iconic label depicts the [further comprises at least one drawing to depict] symptoms which the consumption of the medicine by a patient is expected to alleviate.

7. (Once Amended) A method for marking a medicine receptacle comprising:
affixing a label about the exterior of a receptacle; and
providing on the label a descriptive, non-textual iconic representation that describes the medicine [communicating why the medicine has been prescribed].

8. (Once Amended) The method of claim 7 wherein said step of providing further comprises [communicating] depicting a desired result of a patient consuming the medication.

11. (Once Amended) An icon for marking a medicine receptacle, comprising:
a label having first and second sides;
said first side having an adhering surface and said second side having an external printable media;
a descriptive graphic conveying to a patient the type of medicine within the receptacle [communicating why the medicine has been prescribed, said graphic affixed to said external printable media].

[12. The container of claim 1 wherein said graphical is a colored symbol.]

-- 13. (New) The icon of claim 11, wherein said descriptive graphic depicts the symptoms which the medicine is used to treat. –

--14. (New) The icon of claim 11, wherein said descriptive graphic depicts the reason why the medicine is taken. –

--15. (New) The icon of claim 11, wherein said descriptive graphic depicts the ailment that the medicine treats. –

--16. (New) The icon of claim 11, wherein said descriptive graphic depicts the results of consumption of the medicine. –

-- 17. (New) A label for marking a medicine container, comprising:
a descriptive, non-textual icon that graphically describes the medicine in the container. –

-- 18. (New) The label of claim 17, wherein said icon does not contain any alphanumeric characters. –

-- 19. (New) A device for describing the medicine contained in a medicine receptacle, comprising:

a label having a picture that alone identifies the medicine, said label being capable of mounting to the receptacle. –

-- 20. (New) The device of claim 19, wherein said picture depicts why the medicine is being used. --

-- 21. (New) The device of claim 20, wherein said picture depicts the body part for which the medicine is being used. --

APPENDIX B

FULL SET OF PRESENT CLAIMS

1. A receptacle for medicine, comprising:
a housing having an open end and an external surface, said housing configured to retain dosages of the medicine;
a cover to be removably secured to said open end, said cover separating the medicine held within from an outside environment; and
a descriptive iconic label capable of identifying the medicine without reference to another source.
2. The apparatus of claim 1 wherein said iconic label is disposed on said external surface.
3. (Deleted)
4. The apparatus of claim 1 wherein said iconic label depicts the reason why the medicine is being used.
5. The apparatus of claim 1 wherein said iconic label depicts the results of the consumption of the medicine by a patient.
6. The apparatus of claim 1 wherein said iconic label depicts the symptoms which the consumption of the medicine by a patient is expected to alleviate.

7. A method for marking a medicine receptacle comprising:
affixing a label about the exterior of a receptacle; and
providing on the label a descriptive, non-textual iconic representation that describes the medicine.
8. The method of claim 7 wherein said step of providing further comprises depicting a desired result of a patient consuming the medication.
9. The method of claim 7 wherein said step of providing further comprises communicating symptoms which consumption of the medicine by a patient is expected to alleviate.
10. The method of claim 7 wherein the receptacle has a cover and said step of affixing further comprises affixing the label to the cover.
11. An icon for marking a medicine receptacle, comprising:
a label having first and second sides;
said first side having an adhering surface and said second side having an external printable media;
a descriptive graphic conveying to a patient the type of medicine within the receptacle.
12. (Deleted)

13. The icon of claim 11, wherein said descriptive graphic depicts the symptoms which the medicine is used to treat.
14. The icon of claim 11, wherein said descriptive graphic depicts the reason why the medicine is taken.
15. The icon of claim 11, wherein said descriptive graphic depicts the aliment that the medicine treats.
16. The icon of claim 11, wherein said descriptive graphic depicts the results of consumption of the medicine.
17. A label for marking a medicine container, comprising:
a descriptive, non-textual icon that graphically describes the medicine in the container.
18. The label of claim 17, wherein said icon does not contain any alphanumeric characters.
19. A device for describing the medicine contained in a medicine receptacle, comprising:
a label having a picture that alone identifies the medicine, said label being capable of mounting to the receptacle.
20. The device of claim 19, wherein said picture depicts why the medicine is being used.

21. The device of claim 20, wherein said picture depicts the body part for which the medicine is being used.